

FAX TRANSMISSION

DATE: April 18, 2003

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Patent Number

FAX RECEIVED

Applicant: James Benn *et al.*

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GROUP 1600

MESSAGE TO: Examiner Jeffrey Fredman (Group Art Unit: 1637)

FAX NUMBER: (703) 305-3014

FROM: Lahive & Cockfield, LLP
Peter C. Lauro, Esq.

OFFICIAL

PHONE: (617) 227-7400
FAX NUMBER: (617) 742-4214

PAGES (Including Cover Sheet): 6

CONTENTS: 1) Transmittal Letter (1 page, *in duplicate*); and
2) Response to Restriction Requirement (3 pages).

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Lahive & Cockfield, LLP
28 State Street, Boston, Massachusetts 02109
Telephone: (617) 227-7400 Facsimile: (617) 742-4214

**LAHIVE
&
COCKFIELD**
L L P

COUNSELLORS AT LAW
28 STATE STREET
BOSTON, MASSACHUSETTS 02109-1784
TELEPHONE (617) 227-7400
FAX (617) 742-4214
lc@lahive.com

JOHN A. LAHIVE, JR. (1928-1967)
THOMAS V. SMURZYNSKI
RALPH A. LOREN
GIULIO A. DeCONTI, JR.
ANN LAMPART HAMMITTE
ELIZABETH A. HANLEY
AMY BAKER MANDRAGOURAS
ANTHONY A. LAURENTANO
KEVIN J. CANNING
JANE E. REMILLARD
DEANN FORAN SMITH
PETER C. LAURO
DEBRA J. MILASINIC, Ph.D.
DAVID J. RIKKERS
DAVID R. BURNS
JOHN S. CURRAN
SEAN D. DETWEILER
MEGAN E. WILLIAMS, Ph.D.

LISA M. DIROCCO
HATHAWAY P. RUSSELL *
MARIA LACDOTRIPE ZACHARAKIS, Ph.D.
VINCENT P. LOCCISANO
MERIDETH C. ARNOLD
DANIELLE L. HERRITT
EUIHOON LEE **

SENIOR COUNSEL
JAMES E. COCKFIELD

OF COUNSEL
JEREMIAH LYNCH
WILLIAM A. SCOFIELD, JR.
SIBLEY P. REPPERT
JEANNE M. DIGIORGIO
CYNTHIA L. KANIK, Ph.D.

PATENT AGENTS
THEODORE R. WEST
SHAYNE Y. HUFF, Ph.D.
CYNTHIA M. SOROS
PETER W. DINI, Ph.D.
JONATHAN M. SPARKS, Ph.D.

TECHNICAL SPECIALISTS
CATHERINE M. BISHOP
JACOB G. WEINTRAUB
CRISTIN E. HOWLEY, Ph.D.
JILL ANN MELLO, Ph.D.

* Admitted in TX only

** Admitted in CT only

April 18, 2003

VIA FACSIMILE

Commissioner for Patents
Washington, D.C. 20231

Re: Patent Application Serial No. 09/939,011
Entitled: *Device Identifying the Presence of a Nucleotide Sequence in a DNA Sample*
Inventors: James Benn *et al.*
Filed: August 24, 2001
Group Art Unit: 1637
Attorney Docket No.: GEN-007ACP

Dear Sir:

I enclose herewith for filing in the above-identified application the following:

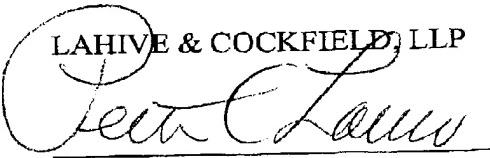
1. Response to Restriction Requirement (3 pages).

Please charge any necessary fees to our Deposit Account No. 12-0080. The undersigned requests any extensions of time necessary to respond. *A duplicate of this sheet is enclosed.*

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| April 18, 2003 | |
| Date | |
| Peter C. Lauro, Esq. | Reg. No. 32,360 |

Respectfully submitted,

LAHIVE & COCKFIELD, LLP


Peter C. Lauro
Reg. No. 32,360
Attorney for Applicants

Date: April 18, 2003

**LAHIVE
&
COCKFIELD**
L L P

COUNSELLORS AT LAW
28 STATE STREET
BOSTON, MASSACHUSETTS 02109-1784
TELEPHONE (617) 227-7400
FAX (617) 742-4214
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SENIOR COUNSEL
JAMES E. COCKFIELD

OF COUNSEL
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April 18, 2003

DUPLICATE

VIA FACSIMILE
Commissioner for Patents
Washington, D.C. 20231

Re: Patent Application Serial No. 09/939,011
Entitled: *Device Identifying the Presence of a Nucleotide Sequence in a DNA Sample*
Inventors: James Benn et al.
Filed: August 24, 2001
Group Art Unit: 1637
Attorney Docket No.: GEN-007ACP

Dear Sir:

I enclose herewith for filing in the above-identified application the following:

1. Response to Restriction Requirement (3 pages).

Please charge any necessary fees to our Deposit Account No. 12-0080. The undersigned requests any extensions of time necessary to respond. *A duplicate of this sheet is enclosed.*

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| April 18, 2003 | |
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| Peter C. Lauro, Esq. | |
| Reg. No. 32,360 | |

Respectfully submitted,

LAHIVE & COCKFIELD, LLP


Peter C. Lauro
Reg. No. 32,360
Attorney for Applicants

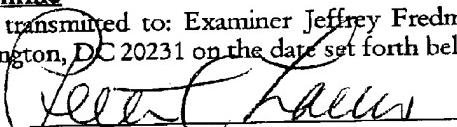
Date: April 18, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**In re the application of:** James Benn *et al.***Serial No.:** 09/939,011**Filed:** August 24, 2001**For:** *Device for Identifying the Presence of a Nucleotide Sequence in a DNA Sample***Attorney Docket No.:** GEN-007ACP**Group Art Unit:** 1637**Examiner:** Jeffrey Fredman**VIA FACSIMILE**Commissioner for Patents
Washington, D.C. 20231**Certificate of Facsimile**

I hereby certify that this correspondence is being facsimile transmitted to: Examiner Jeffrey Fredman, at Facsimile No. 703-305-3014, Commissioner for Patents, Washington, DC 20231 on the date set forth below.

April 18, 2003

Date of Signature and of Facsimile Transmission

By: Peter C. Lauro, Esq.
Reg. No. 32,360
Attorney for Applicants**RESPONSE TO RESTRICTION REQUIREMENT**

Dear Sir:

This is in response to the restriction requirement set forth in the Office Action dated March 20, 2003 (Paper No. 6).

The Examiner has required restriction to one of the following groups under 35 U.S.C. § 121:

Group I: claims 1-31, (drawn to nucleic acid detection devices, classified in class 435, subclass 287.1); and

Group II: claim 32 (drawn to methods of nucleic acid detection, classified in class 435, subclass 6).

Applicants are required to elect one of the above groups for prosecution on the merits.

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Attorney Docket No.: GEN-007ACP

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Group Art Unit: 1637

Applicants respectfully traverse the requirements for restriction and election, and submit that the requirements are improper. First, Applicants assert that the subject matter of these groups represent different embodiments of a single inventive concept for which a single patent should issue. The pending claims represent an intricate web of knowledge,

continuity of effort, and consequences of a single invention, which merit examination of all of these claims in a single application. More particularly, a single, searchable, unifying aspect, *i.e.*, a flat plate detection cell for detecting of the presence or absence of a sequence in a target DNA sample, links all of the claims.

Moreover, the patent statutes require that Applicants disclose how to make and use the nucleic acid detection system and method of the invention. It is only reasonable, then, that Applicants be allowed to prosecute the system and the method for using the system in a single application. For example, the method of claim 32 specifically recites the use of the *flat plate detection cell*, set forth in the apparatus claims 1-31. Therefore, it is improper to require that the subject matter of these groups be prosecuted in separate patent applications.

Second, Applicants submit that a sufficient search and examination with respect to the subject matter of all claims can be made without serious burden. As the M.P.E.P. states:

[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. M.P.E.P. § 803 (8th ed., Rel. 78A, August 2001).

That is, even if the above-enumerated groups of claims are drawn to distinct inventions, the Examiner must still examine the entire application on the merits because doing so will not result in a serious burden.

Applicants submit that the search and examination of all the claims will have substantial overlap, and no serious burden will result from searching and examining all claims in the same application. This is especially true inasmuch as Groups I and II share the same classification, *i.e.*, class 435 and the flat plate detection cell of claims 1-31 is also recited in claim 32.

In view of this identity of classifications, and the data bases and powerful computer search engines available to the Examiner, there would be no serious burden in examining all the claims in a single application.

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Attorney Docket No.: GEN-007ACP

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Group Art Unit: 1637

Therefore, in the interest of savings of time and cost to Applicants and the Patent Office, Applicants respectfully request that all the claims be rejoined and searched and examined in a single application.

Nevertheless, in compliance with the directives in the Office Action and in order to expedite prosecution of the instant application, Applicants hereby elect, subject to the foregoing traverse, Group I (claims 1-31).

If a telephone conversation with Applicants' attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call the undersigned attorney at (617) 227-7400.

Respectfully submitted,



Peter C. Lauro, Esq.
Reg. No. 32,360
Attorney for Applicants

LAHIVE & COCKFIELD, LLP
28 State Street
Boston, MA 02109
Tel. (617) 227-7400

Dated: April 18, 2003